

REMARKS

Claims 1-23 were filed on September 5, 2003. In the Office Action mailed on July 14, 2004, the Examiner rejected Claims 1, 4-8, 16-17 and 20 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,686,770, issued to Davis ("the Davis Reference"). The Examiner rejected Claims 9, 13 and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,397,448, issued to Cobb ("the Cobb Reference"). Claims 10-12, 14 and 19 were rejected under 35 U.S.C. §103(a) as being obvious over the Cobb Reference in view of U.S. Patent No. 4,610,093, issued to Jarman et al. ("the Jarman Reference"). Claims 15 and 21-23 were rejected under 35 U.S.C. §103(a) as being obvious over the Davis Reference in view of the Cobb Reference. The Examiner objected to Claims 2 and 3 as being dependent upon a rejected base claim and stated that they would be allowable if rewritten in independent form to include the limitations of Claim 1.

Applicants have considered the Office Action and have amended the claims. Specifically, independent Claim 1 has been amended to incorporate limitations from Claim 2, resulting in the cancellation of Claim 2. Independent Claims 16 and 20 have also been amended to recite additional structure. Based upon these amendments and the following remarks, Applicants respectfully submit that the claims remaining in the application, i.e., Claims 1 and 3-23, are in condition for allowance.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1, 4-8, 16-17 and 20

The Examiner rejected Claims 1, 4-8, 16-17 and 20 under 35 U.S.C. §102(b) as being anticipated by the Davis Reference. The Examiner also stated that Claim 2, which is dependent from Claim 1, would be allowable if rewritten in independent form to include the limitations of Claim 1. Applicants have amended Claim 1 to include the structure recited in Claim 2 and therefore respectfully submit that amended Claim 1 is now in condition for allowance. Applicants have

canceled Claim 2 to reflect its inclusion in amended independent Claim 1. Because Claims 3-8 depend from allowable amended Claim 1, Applicants respectfully submit that these claims also are in condition for allowance.

Independent Claims 16 and 20 are method claims that involve use of the apparatus recited in Claim 1. Claims 16 and 20 have been amended in a manner similar to that of Claim 1, i.e., to include limitations recited in Claim 2. Therefore, Applicants submit that amended Claims 16 and 20 are also allowable. Applicants further submit that Claim 17, depending from allowable Claim 16, is allowable.

Claims 9, 13 and 18

The Examiner rejected Claims 9, 13 and 18 under 35 U.S.C. §102(b) as being anticipated by the Cobb Reference. Applicants respectfully submit that independent Claims 9 and 18 are not anticipated by Cobb, nor is Claim 13, which is dependent from Claim 9, since the Cobb Reference discloses a structure and function that are different from that recited in Claims 9 and 18.

It is well settled that all words in a claim must be taught by a reference for an anticipation rejection to be valid. *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985). In addition, a reference cannot anticipate a claim simply by having components that may be similar to the elements recited in the claim. Rather, the components disclosed in the reference must have the same structure as the claimed elements and must be understood by one skilled in the art to function in the same way as the claimed elements. *Applied Medical Resources Corp. v. United States Surgical Corp.*, 147 F.3d 1374, 1380 (Fed. Cir. 1998). Furthermore, any such disclosure by a prior art reference must be enabling. *Minnesota Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1306 (Fed. Cir. 2002).

The Cobb Reference discloses a method of locating parallel mounting points that uses a laser 30, 40, 42. (Col. 3, ll. 37-64.) As shown in FIG. 3, laser 30 emits a laser beam 38 that projects parallel to the length of undercarriage 18 of the trailer (Col. 3, ll. 44-56):

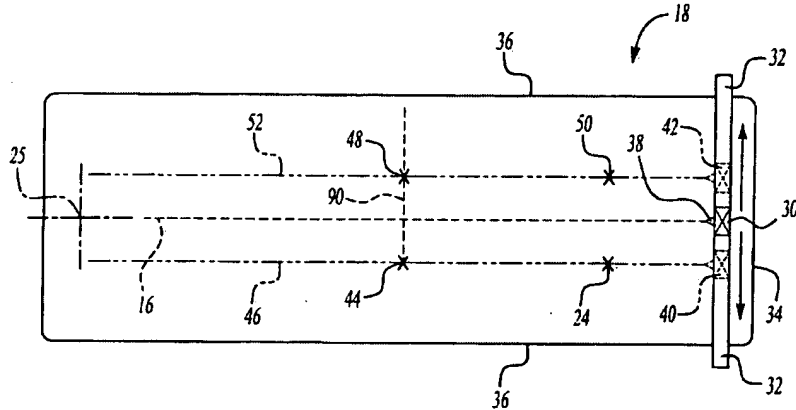


Fig-3

The Cobb Reference states that the manufacturer measures to locate a first rail mounting point 24 and then mounts a target 26 to that first point. (Col. 3, ll. 27-30.) Target 26 is shown in FIG. 4:

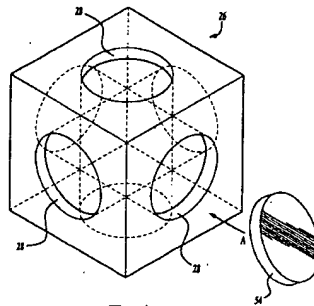
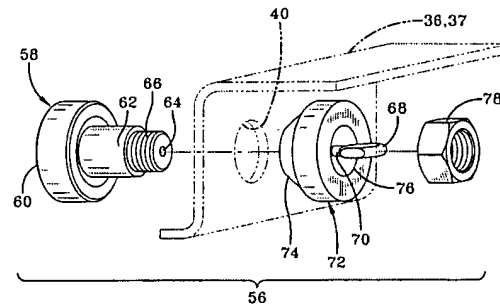


Fig-4

Target 26 is a cube that is mounted to undercarriage 18 and includes ports 28 so that beam 38 of laser 30 can pass inside the target and be reflected up to the undercarriage, where the resulting spot is physically marked with a punch. (Col. 3, ll. 30-37 and col. 3, l. 64-col. 4, l. 6.) Laser beam 38 is then allowed to pass through target 26 and a second target is used in the same manner as the first to create second rail mounting point 44 parallel to first point 24. (Col. 4, ll. 16-29.) Beam 38 is

reference member attached to the frame rails, using a rail extender assembly, which is what Claims 9 and 18 respectively recite.

Furthermore, Claims 9 and 18 recite a rail extender assembly that is removably mountable on selected ones of said frame rails. An exemplary rail extender assembly is shown in FIG. 5:



As recited, rail extender assembly 56 mounts in a removable manner directly to one of frame rails 36, 37. In contrast, target 26 of the Cobb Reference is never actually mounted on a rail. Instead, target 26 of Cobb mounts to undercarriage 18 of trailer 10 and is used to facilitate the marking of a location for the rails on the undercarriage. (Col. 3, l. 30 – col. 4, l. 6; col 4, ll. 26-38.) Therefore, the rail extender assembly that is removably mountable on the frame rails, as recited in Claims 9 and 18, is not disclosed by the Cobb Reference.

Because the Cobb Reference lacks elements that are recited in Claims 9 and 18, Applicants respectfully submit that Cobb does not anticipate Claim 9 or Claim 18. Therefore, these claims are allowable. In addition, because Claim 13 is dependent from Claim 9, Applicants respectfully submit that it, too, is allowable.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 10-12, 14 and 19

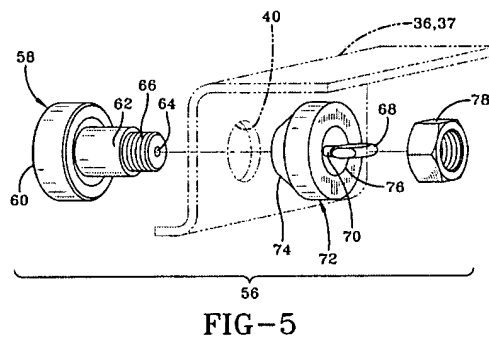
The Examiner rejected Claims 10-12, 14 and 19 under 35 U.S.C. §103(a) as obvious over the Cobb Reference in view of the Jarman Reference. Applicants first submit that Claims 10-12, 14 and 19 are allowable since all of these claims depend from allowable independent claims. That is, Claims 10-12 and 14 depend from independent Claim 9, and Claim 19 depends from independent Claim 18, both of which are allowable based on the remarks presented above.

In addition, Applicants respectfully submit that expressly recited elements of Claims 10-12, 14 and 19 are not taught, alone or in combination, by the Cobb Reference and the Jarman Reference. All of the words recited in a claim must be taught by the cited references for an obviousness determination to be valid. *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). The Examiner relies upon Cobb for its disclosure of a “vehicle alignment measurement apparatus” and refers back to the anticipation rejection of Claims 9, 13 and 18. As described above, however, Cobb does not teach the structure or method to measure from a kingpin to a rail, nor the use of a rail extender assembly that is removably mountable on the frame rails, as recited in Claims 9 and 18. These elements are incorporated into respective dependent Claims 10-12, 14 and 19, showing that Cobb does not teach a vehicle alignment measurement apparatus as recited in these claims.

Moreover, Applicants respectfully submit that the Cobb Reference teaches away from the claimed invention and thus does not render the invention obvious. *In re Haruna*, 249 F.3d 1327 (Fed. Cir. 2001). The measurements described in the Cobb Reference are taken after an initial measurement is made by the manufacturer to determine first point 24. (Col. 3, 11.27-30.) Cobb fails to teach any control over this initial measurement, resulting in questionable repeatability of the method. In contrast, one of the primary objectives of the claimed structure and method of the invention is to provide a repeatable measurement from a kingpin to a frame rail. (Page 2, ll. 28-30;

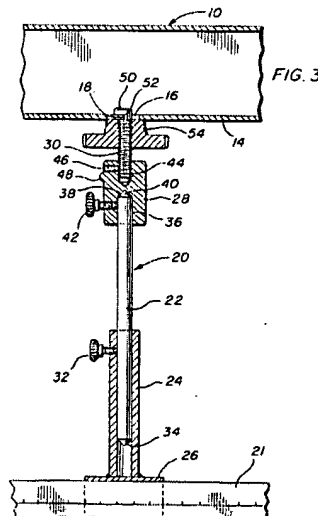
page 9, l. 32 – page 10, l. 2.) The lack of such repeatability in Cobb shows that it teaches away from the claimed invention, precluding its use for a finding of obviousness. As a result, Applicants submit that any rejection of Claims 10-12, 14 and 19 premised upon a vehicle alignment measurement apparatus of Cobb is not proper.

Regarding additional elements recited in Claims 10, 12, 14 and 19, the Examiner relies upon the Jarman Reference. The Examiner compares Jarman to Claim 10 of the Application. Claim 10 recites a rail extender assembly that is shown in an exemplary manner in FIG. 5:



Rail extender assembly 56 includes a base 60 from which a shaft 62 extends. A positioning member 72 defines a central bore 76 that receives shaft 62, and a tapered outer surface 74 of the position member engages a rail orifice 402.

In contrast, Jarman discloses a gauge member 20 that is shown in FIG. 3:



Gauge member 20 of Jarman includes a central shank member 22 that seats in a vertical sleeve 24, which is supported by a horizontal sleeve 26. (Col. 2, ll. 48-59.) A connecting fitting 28 is disposed at the upper end of shank 22 and receives a threaded shank 30, which extends through a bore 16 in frame 10. (Col. 3, ll. 2-11 and 37-43.) A hand nut 54 is included on threaded shank 30 and is tightened up against vehicle frame 10. (Col. 3, ll. 30-45.)

In the Office Action, the Examiner compares hand nut 54 of Jarman to the positioning member recited in Claim 10, stating that the hand nut engages a frame rail orifice. Hand nut 54 of Jarman, however, does not engage an orifice, instead only abutting bore 16. This difference is both structural, i.e., engaging as opposed to abutting, and functional, as the engagement of the positioning member recited in Claim 10 acts to center the member in the orifice, which is completely lacking in the Jarman Reference. As a result, Applicants respectfully submit that Jarman does not teach an expressly recited element of Claim 10. The Examiner also compares central shank member 22 and hand nut 54 of Jarman to the shaft received by a central bore in the positioning member recited in Claim 10. The Examiner states that hand nut 54 defines a central bore that receives shank 22. As shown in FIG. 3 of the Jarman Reference, however, hand nut 54 does not receive central shank member 22. Therefore, Jarman lacks another element recited in Claim 10. As a result, Jarman does not teach elements that are recited in Claim 10 and Applicants respectfully submit that the rejection of Claim 10, as well as Claims 11 and 12 depending therefrom, is not proper.

Turning to Claims 14 and 19, each of which recites the use of a tape extensometer, the Examiner again relies upon the Jarman Reference, asserting that gauge bars 21 of Jarman are a tape extensometer. As FIG. 3 from Jarman shows (above), gauge bars 21 are rigid bars that are structurally different from the flexible, yet firm, tape extensometer which extends between the reference members. (Page 6, ll. 5-15 of the Application.) Due to such a difference, Applicants

respectfully submit that the Jarman Reference does not teach the use of a tape extensometer and the rejection of Claims 14 and 19 is therefore not proper.

For these reasons, Applicants respectfully submit that elements of Claims 10-12, 14 and 19 are not taught, either alone or in combination, by the Cobb Reference and the Jarman Reference, precluding any finding of obviousness.

Claims 15 and 21-23

The Examiner rejected Claims 15 and 21-23 under 35 U.S.C. §103(a) as being obvious over the Davis Reference in view of the Cobb Reference. Applicants respectfully submit that expressly recited elements of Claims 15 and 21-23 are not taught, alone or in combination, by the Davis Reference and the Cobb Reference.

First, Applicants submit that there is no suggestion to combine Davis and Cobb, precluding any finding of obviousness. The teachings of two prior art references can be combined only when there is some suggestion in the references to do so. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Davis and Cobb teach totally separate inventions and contain no suggestion to be combined. In particular, the Davis Reference discloses an apparatus for mounting on wheel ends to align trailer axles, which is typically done in the field, as Davis expressly reviews the disadvantages of prior art systems that undesirably required removal of the trailer wheels. (Col. 1, ll. 14-21.) In contrast, the Cobb Reference discloses a method to align rails during manufacturing, as the rails are positioned using the method taught by Cobb, and are then welded to the trailer. (Col. 4, ll. 26-38.) Such disparate structures and techniques do not contain any suggestion to combine, precluding any finding of obviousness based on Davis and Cobb.

Second, Davis and Cobb do not teach all of the words recited in Claims 15 and 21-23. All of the words recited in a claim must be taught by the cited references for an obviousness determination

to be valid. *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). The Examiner states that Davis does not disclose the recitation of Claims 15 and 21 relating to a reference member removably mountable on a selected frame rail, whereby the distance between a reference member mounted on the kingpin and the reference member mounted on the selected frame rail is measured. Rather, the Examiner states that Cobb discloses such elements. As described in detail above, however, Cobb does not teach the structure or apparatus to be used to measure from a kingpin to a rail, nor does Cobb teach the use of a reference member that is removably mountable on the frame rails. Rather, Cobb teaches away from the claimed invention.

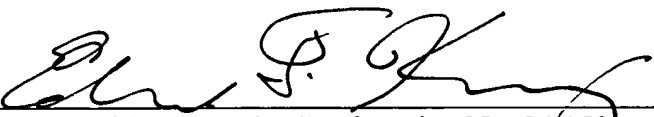
As a result, Applicants respectfully submit that Claims 15 and 21 are not obvious over Davis in view of Cobb. Applicants further submit that Claims 22 and 23, being dependent from Claim 21, are also not obvious.

The results produced by Applicants' invention have long been sought after by those skilled in the art, but up until Applicants' invention, the results have been unobtainable. By distinctly reciting non-obvious aspects of the invention in independent Claims 1, 9, 15, 16, 18, 20 and 21, it is believed that the rejections based on anticipation and obviousness have been overcome. Since Claims 3-8 depend from allowable independent Claim 1, Claims 10-14 depended from allowable independent Claim 9, Claim 17 depends from allowable independent Claim 16, Claim 19 depends from allowable independent Claim 18, and Claims 22 and 23 depend from allowable independent Claim 21, Applicants respectfully submit that these claims are also in condition for allowance.

In view of the above, it is submitted that the claims remaining in the application now are in condition for allowance. Reconsideration of the rejections is respectfully requested and allowance of Claims 1 and 3-23 at an early date is hereby respectfully solicited.

Respectfully submitted,

BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP


By: David P. Dureska, Registration No. 34,152
Edward T. Kennedy, Registration No. 48,478

4518 Fulton Drive, N.W.
P.O. Box 35548
Canton, OH 44735-5548
Telephone: (330) 491-5289
Facsimile: (330) 252-5454
E-Mail: ddureska@bdblaw.com
Attorney Docket No.: HEND-AT-REG (45007-228)